

10/036,566MS177851.01/MSFTP954US**REMARKS**

Claims 1, 18, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37-39, 41, 42, 45-47 and 69 are currently pending in the subject application and are presently under consideration.

Claims 1 and 69 have been amended herein to further emphasize exemplary features of applicants' claimed invention. A version of all pending claims is presented at pages 4-8. In addition, the specification has been amended as indicated on pages 2-3. Further, a terminal disclaimer in compliance with 37 CFR §1.321(c) is filed concurrently with this Reply. Applicants' representative notes however that the Examiner has failed to address the limitations set forth in independent claim 69. Thus, in view of this omission it is believed that independent claim 69 as it currently stands is in condition for allowance. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Information Disclosure Statement

Contrary to the Examiner's assertion in the instant Office Action, the Information Disclosure Statement (IDS) filed May 23, 2003 provides legible copies of the art in question as indicated by the Examiner's initials dated October 18, 2005.

II. Objection to the Specification

The disclosure is objected to because of the following informalities: the blank spaces under the cross-references need to be filled. Withdrawal of this objection is requested in view of the amendment made to the specification to comport with the Examiner's recommendation.

III. Rejection of Claim 1 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

Claim 1 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending U.S. Patent Application No. 11/047,068. A terminal disclaimer is filed herewith in connection with the subject application and copending U.S. Patent Application No. 11/047,068, and therefore this rejection is now moot and should be withdrawn.

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IV. Rejection of Claims 1, 18, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37-39, 41, 42, and 45-47 Under 35 U.S.C. §103(a)

Claims 1, 18, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37-39, 41, 42, and 45-47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Delany *et al.* (US 2002/0156879) in view of Haeri *et al.* (US 2003/0033421). This rejection should be withdrawn for at least the following reasons. Delany *et al.* and Haeri *et al.*, either alone or in combination, fail to teach or suggest all limitations set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Applicants' claimed invention relates to systems and methods for dynamically assigning entities (e.g., people, processes, computer components, etc.) to communication categories to facilitate maximizing utility of communications based on membership in such communication categories. To this end, independent claim 1, as amended, recites: *membership of the group of communicating parties based at least in part on a reciprocated communication history between entities that comprise the group*. Neither Delany *et al.* nor Haeri *et al.*, alone or in combination, teach or suggest these aspects of the invention as claimed.

Delany *et al.* relates to technology for modifying group membership, including self subscription and self unsubscription. The cited document however makes no mention whatsoever of determining membership of a group of communicating parties

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based on a reciprocated communications history that exists between members that comprise the group. Nowhere in Delany *et al.* is this salient feature disclosed or suggested.

Moreover, the Examiner concedes that Delany *et al.* fails to teach an identifier that identifies one or more communication channel that facilitate maximizing the utility of the communication, and thus offers Haeri *et al.* to remedy this deficiency. Haeri *et al.* relates to software program methods for reducing delays in real-time lookup and avoids needing expensive content-addressable memory (CAM). However, the secondary document, like Delany *et al.*, fails to teach or suggest basing group membership on one or more common communication histories that exist between members that comprise the communication group. Accordingly, in the face of the deficiency of both Delany *et al.* and Haeri *et al.* to teach or suggest the elucidated aspect recited in independent claim 1, withdrawal of this rejection with respect to the subject independent claim (and claims that depend there from) is requested.

10/036,566MS177851.01/MSFTP954USCONCLUSION

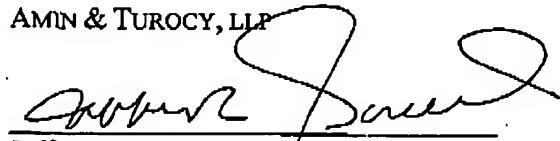
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP954US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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